

## **REMARKS**

Entry of the foregoing amendment is respectfully requested. The amendment is believed to place the application in condition for allowance and is, therefore, appropriate under Rule 116. The amendment does not raise any new issues and, thus, does not require an additional search by the Examiner.

The amendment was not earlier presented because applicants became familiar with new grounds for rejection and became aware of a formal error in claim 3 only after they were first set forth in the final Office action.

With the present amendment, claim 3 is amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejects claims 1 and 2 as being obvious over Heeb et al., European Publication EP 1 027 962 in view of Mitchell, U.S. Patent No. 3,748,770. Claim 3 is rejected as claim 1 and 2 above, and further in view of Dingman, U.S. Patent No. 3,219,866. Claims 5-6 and 7-9 are rejected as claims 1, 2 above and further in view of Giardini, U.S. Patent No. 4,203,393 and Suckewer, U.S. Patent No. 6,321,733, respectively.

It is respectfully submitted that claims 1-9 are patentable over the prior, including all of the prior art of record in this application.

Specifically, claim 1 recites an ignition device for igniting a foil cartridge (10) in an explosion-operated power tool. The ignition device includes:

- (i) a pin-shaped electrode (25) located in the electrical insulator, which is located in a displaceable support (8), and having a tip (30) that communicates with the surrounding environment via channel (32) formed in the electrical insulator (24) and extending a longitudinal direction of the pin-shaped electrode (25); and
- (ii) an electrically conducting annular electrode (27) supported on the support (8) in a region of the channel (32). The annular electrode (27) tightly surrounds the insulator (24), leaving the channel (32) free. The annular electrode (8) is displaceable, together with the support (8), between a first position in which the annular electrode is spaced from the cartridge cover foil, and a second position in which the annular electrodes contacts the cartridge cover foil.

With the pin-shaped electrode communicating with the surrounding environment and, thus with the annular electrode through a channel, the arc generation does not require formation of electrically conductive areas or regions in the foil cartridges.

The arc generation does not depend on properties of the cartridges and, therefore, the arc has always predetermined characteristics and insures a reliable ignition of the cartridge.

Heeb discloses an ignition device including two-pin-shaped electrodes (5, 6) arranged on the support displaceable to and from a foil cartridge (9). When the support abuts the flat surface of the cartridge, the electrodes pierce the foil, igniting the initiating composition (3).

Mitchell, while disclosing a pin-shaped electrode (31) and an annular electrode (32), does not disclose communication of the pin electrode with an annular electrode through a channel formed in the insulator that separates the pin-shaped electrode from the annular electrode. In Mitchell, both electrodes are arranged flush with each other (column 2, lines 35-36). Further, in Mitchell the arc is formed through the munition (cartridge) (column 3, lines 1-6).

Even, *arguendo*, Heeb is combined with Mitchell, there would be provided an ignition device with both annular and pin-shaped electrodes being arranged flush with each other and with the arc being formed through the cartridge. The combination would not include a pin-shaped electrode which is located in the electrical insulator and which communicates with the surrounding environment via

a channel formed in the insulator and extending in the longitudinal direction of the pin-shaped electrode.

As has been discussed previously, under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must reach or suggest all of the claim limitation.

It is respectfully submitted that neither the first element no third element of *prima facie* obviousness have been established.

There is no suggestion, incentive or motivation in Heeb and/or Mitchell for their combination. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie case* of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993).

The Court of Appeals for the Federal Court clarly stated:

It is impermissible to use the claimed invention as an instruction manual or template to pierce together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992).

The In re Fritch holding only confirmed a long-established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that those teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Heeb and Mitchell can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself....Something in the prior art

as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office action. The same court further states:

“... it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In view of the above it is respectfully submitted that the combination of Heeb and Mitchell does not make obvious the present invention, as defined in claim 1, and the present invention as defined by claim 1 is patentable over said combination.

Claims 2-9 depend on claim 1 and are also allowable.


### **CONCLUSION**

In view of the foregoing it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or amended or corrected in formal respects, in order to place the case in condition for final allowance e, then it is respectfully requested that such amendment or correction be carried out by

Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, reading "Alexander Zinchuk", written in dark ink.

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Date: August 2, 2005

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Alexander Zinchuk

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